

Appln No. 10/510,094
Amdt. Dated: December 20, 2006
Response to Office Action of October 25, 2006

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REMARKS/ARGUMENTS

1. The Applicant has carefully considered the official communication dated October 25, 2006. Applicant respectfully submits that the amendment and the following remarks are fully responsive to the official communication.
2. The claims have been amended in light of the official communication. It is submitted that no new matter has been added as a result of the amendment.
3. In paragraph 2 of the Detailed Action, the Examiner has rejected claims 1 to 5 under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 5,847,836) in view of Hatada (US 4,270,853) and Sharma (US 5,726,693).
4. In the case of *Hodosh v Block Drug Co. Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed Cir. 1986) it was held that the following rules should apply to obviousness rejections (from MPEP 2141):
 - (A) The claimed invention must be considered as a whole;
 - (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
 - (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
 - (D) Reasonable expectation of success is the standard with which obviousness is determined.
5. The Examiner states in Paragraph 2 of the Detailed Action that "it would have been obvious ... to provide the photo width printing and the magnetic recording portion for audio to the invention of Suzuki in order to enhance the enjoyment ...". However, when considering criterion (B) in the test recited in paragraph 4 above, this criterion is not made out as Suzuki does not teach or "suggest the desirability and thus the obviousness of making the combination" as required.
6. Furthermore, criterion (C) of the test is not made out as the claimed combination of features is only obvious in hindsight, owing to the absence of any teaching or suggestion to the claimed combination of features in any of the citations, and is therefore not permissible.
7. Similar arguments apply in relation to the Examiner's comments in paragraph 5 of the Detailed Action.

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8. In any event, we propose amending claim 1 to further distinguish claim 1 from the citations. Claim 1 now emphasizes that the print media is treated so that it is magnetically sensitive and includes an expansive magnetic recording surface which is at least the same size as said printed image (e.g. over the whole back surface of the printed image). Accordingly, claim 1 relates to a camera including a magnetic recording means for recording associated information on the treated and expansive magnetic recording surface. These features are described in the penultimate paragraph on page 4 of the specification, and are neither disclosed nor suggested in any of the citations.
9. Most pertinently, Hatada discloses a respective strip sheet 9 of magnetic material (see lines 53-55, col. 2 and Figure 2) which is affixed to the print media 5. Similarly, Kelley (US 4,905,029) also discloses a strip plastic tape recording medium 24 (see lines 51-53, col. 3 and Figure 1) which is affixed to print medium 22.
10. The term "expansive" plainly means "broad in size or extent", and thereby precludes the strip magnetic recording surfaces of Hatada and Kelley on which only a limited amount of information can be stored. An expansive magnetic recording surface capable of storing significantly more information is not disclosed in any of the citations. Accordingly, it is respectfully submitted that claim 1 would not be obvious in light of those citations.
11. Furthermore, claim 1, as amended, emphasizes that the actual print media is treated to form the magnetic recording surface. In contrast, the magnetic recording strips of Hatada and Kelley are separately formed from the print media, and then fixed to the print media which involves an additional fixing process step. Treatment of the actual print media to avoid a fixing process step is not disclosed in any of the citations. Accordingly, Applicant respectfully submits that claim 1, as amended, is not be obvious in light of those citations.
12. In addition, a magnetic recording means for recording information on the treated and expansive magnetic recording surface is not disclosed in any of the citations and, accordingly, Applicant respectfully submits that claim 1 would not be obvious in light of those citations.
13. Applicant respectfully submit that claims 2 to 5 are also not obvious, as they depend upon claim 1 which Applicant respectfully submits is not obvious for the reasons outlined above.
14. Applicant has inserted a paragraph entitled "Cross-Reference to Related Applications" at Page 1 of the specification. This information was shown in the Declaration filed with the application papers dated August 31, 2004. Applicant submits that this amendment introduces no new matter.

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It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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